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EXAMINER

LEWIS, TISHA D

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/064,508
Filing Date: July 23, 2002
Appellant(s): ISODA ET AL.

Ernest A. Beutler
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 13, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

1. The examiner has withdrawn the claims 2, 3 and 6 from the anticipated rejection under 35 USC 102(b) by U.S. patent 5,681,239 to Toukura. Therefore, claims 1, 5, 7-9 and 11 are the only claims under appeal pertaining to this rejection to Toukura.

2. The examiner has withdrawn the claims 2, 3 and 6 from the anticipated rejection under 35 USC 102(e) by U.S. patent 6,343,586 to Muto et al. Therefore,

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claims 1, 5, 7-9 and 11 are the only claims under appeal pertaining to this rejection to Muto et al.

3. The examiner has withdrawn the claim 4 from the obvious rejection under 35 USC 103(a) from Toukura in view of U.S. patent 5,086,741 to Nakamura et al.

4. The examiner has withdrawn the claim 4 from the obvious rejection under 35 USC 103(a) from Muto et al in view of U.S. patent 5,086,741 to Nakamura et al.

5. The examiner has withdrawn the claims 13-20 from the obvious double patenting rejection in view of U.S. patent 6,701,893 to Isoda et al. Therefore, claims 1-9 and 11 are the only claims under appeal pertaining to this rejection to Isoda et al.

(7) Grouping of Claims

1. The rejection of claims 1, 5, 7-9 and 11 under 102(b) stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together **and reasons in support thereof**. See 37 CFR 1.192(c)(7).

2. The rejection of claims 1-9 and 11 under the double patenting stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together **and reasons in support thereof**. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

A substantially correct copy of appealed claims 1-9 and 11-20 appears on page 8-10 of the Appendix to the appellant's brief. The minor errors are as follows: claim 10 was not inserted. Claim 10 is as follows: A vehicle transmission system protection by

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engine control method for a vehicle as set forth in claim 1 wherein the transmission system is comprised of a clutch and a transmission and the avoided undesirable transmission system condition is clutch chattering.

(9) Prior Art of Record

5,681,239	Toukura	10-1997
6,343,586	Muto et al	2-2002
6,701,893	Isoda et al	3-2004

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Toukura ('239).

As to claims 1 and 11, Toukura discloses an engine control method for a vehicle wherein rotation of the engine is transmitted to a driven wheel through a transmission (column 2, lines 32-34 discloses an alternative of having a transmission with the engine for driving the vehicle), Toukura discloses detecting during engine acceleration (correlating to the vehicle acceleration in step S23 in Figure 3, because the engine has to be accelerating to provide torque for the vehicle to accelerate and also has to be

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accelerating for the sensor 8 to detect rotation position of the engine), variations in the rotational state of a shaft and if the degree of change in variation is excessive and will cause difficulties in the transmission system, restricting engine output if the degree of change in the shaft is excessive, (correlating to the above, the sensor 8 of Toukura is used to detect engine speed, column 3, lines 54-57 which is detected at the drive shaft wherein engine speed can only be detected according to rotation of the drive shaft; therefore, Toukura detects engine speed variation in accordance with the sensor above by the drive shaft. The variation detected is determined to be between a positive rate (DELTNE) wherein the engine speed variation exceeds a predetermined value (TRDNE) and a negative rate wherein the engine speed variation is below that value. If the engine speed variation exceeds the positive rate then an ignition timing is retarded (abstract, column 6, lines 3-7) that delays engine fuel for providing torque to the engine to drive the shaft which correlates to restricting output of the engine if the variation change in the drive shaft is excessive. Vibration control of the drive shaft will also provide vibration control to the transmission since Toukura discloses an alternative of having the engine connected to a transmission (column 2, lines 32-34) wherein if vibration is controlled, difficulties in the transmission system will be prevented).

As to claim 5, Toukura discloses detecting engine speed variation according to engine rotation position during engine acceleration (as disclosed in the rejection above for claims 1 and 11) which correlates to change in degree of engine rotational state by both rotational variation and rotational acceleration.

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As to claim 7, Toukura discloses spark plugs (19) which are used to ignite the engine fuel wherein ignition timing change correlates to spark timing in which the timing is retarded (abstract) to vary the engine output.

As to claim 8, Toukura discloses that the ignition timing is corrected (changed) by a counter (column 4, lines 17-35).

As to claim 9, Toukura discloses the corrected ignition timing being feedback to the control to retard the timing which delays fuel to the engine wherein the engine speed will be reduced.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5, 7-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Muto et al ('586). As to claim 1, Muto et al discloses an engine control for a vehicle in which rotation of an engine is transmitted to a driven wheel through a transmission (column 4, lines 46-49). Muto et al discloses detecting during engine acceleration (correlating to the vehicle acceleration, because the engine has to be accelerating to provide torque for the vehicle to accelerate and also has to be accelerating for the sensor 22 to detect rotation position of the engine), variations in the rotational state of a shaft (column 9, lines 55+) and if the degree of change in variation is excessive and will cause difficulties in the transmission system, restricting engine output if the degree of change in the shaft is excessive, (correlating to the above, Muto et al uses an engine speed variation (dln_{ea}) to control engine output wherein (column 11, lines 44-52) if the

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variation is a positive value in which the engine speed is increasing above a predetermined value (dlne), an ignition efficiency (raop) is set to a small value which retards ignition timing to reduce engine output). The control system of Muto et al is provided to control vibration (abstract) which will also provide vibration control to the transmission since Muto et al discloses having the engine connected to a transmission (column 4, lines 46-49) wherein if vibration is controlled, difficulties in the transmission system will be prevented).

As to claim 5, Muto et al discloses detecting engine speed variation according to engine speed during engine acceleration (as disclosed in the rejection above for claims 1 and 11) which correlates to change in degree of engine rotational state by both rotational variation and rotational acceleration.

As to claim 7, Muto et al discloses spark plugs (11) which are used to ignite the engine fuel wherein ignition timing change correlates to spark timing in which the timing is retarded (abstract) to vary the engine output.

As to claims 8 and 9, Muto et al discloses that the ignition timing is controlled by a calculation timing according to the ignition efficiency (raop) and the efficiency feedbacks to the control to retard the timing which delays fuel to the engine wherein the engine speed will be reduced (i.e., column 10, lines 53-67).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,701,893. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission system and detecting during engine acceleration variations in the rotational state of the shaft if the degree of change in variation of the shaft is excessive and restricting an engine output if the change is excessive.

(11) Response to Argument

Appellant's arguments filed in the appeal brief are acknowledged, but are not persuasive. As to appellant's argument pertaining to the functions of the prior art being different from the functions of the present invention in controlling engine torque, appellant seems to be suggesting that reducing engine output (provided in Muto et al and Toukura) is different from preventing or restricting output wherein as disclosed above in the rejections, if the ignition timing is delayed/retarded, then engine output is prevented for a period of time which correlates to the terms preventing or restricting.

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As to appellant's argument pertaining to the sensor use of the present invention, this is not provided as a claim limitation and therefore, will not be responded to by the examiner.




As to appellant's argument pertaining to the differences between the claim limitations and the prior art, the rejections above are set forth to explain how the features of the prior art correspond to the claim limitations of the present invention.


As to appellant's argument pertaining to the double patenting rejection suggesting that applicant has a right to an invention utilizing the same principles in both the present application and the patent (Isoda 6,701,893), the examiner agrees that applicant should have a right to have a patent on the present invention using the same principles as in the patent, but that does not mean that a double patent rejection can not be made between the two concerning what is claimed in both. It seems that appellant is trying to use the disclosure to overcome this rejection (since the wheel slippage is not a limitation in at least claim 1 of the patent) when in fact the analysis for a double patent rejection is on the claims not the disclosure (MPEP 804). Although different problems are being solved between the present application and the patent, the same (exact) engine control is being claimed to solve these problems in which the claims of the present application are encompassed in the claims of the patent. For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

tdl
March 21, 2005

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